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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/677,815	10/03/2000	Espen Skjaeran	28170-00023	5535

27045 7590 07/12/2004

ERICSSON INC.  
6300 LEGACY DRIVE  
M/S EVR C11  
PLANO, TX 75024

EXAMINER
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YUSSUF, SAJID

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 07/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/677,815

Applicant(s)

SKJAERAN ET AL.

Examiner

Sajid A Yussuf

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2000 and 07 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2 and 3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2 and 3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 October 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Response to Arguments***

1. Applicant's arguments, see page 6, 2<sup>nd</sup> paragraph, filed June 07, 2004, with respect to claims 2 and 3 have been fully considered and are persuasive. The final rejection of claims 2 and 3 has been withdrawn.

***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Drawings***

3. Figure 1, 2, 3, 4 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of

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the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

**6. Claim(s) 2-3 is/are rejected under 35 U.S.C. 102(e) as being anticipated by Gardell et al. (US Patent No. 6,128,304 and Gardell hereinafter).**

7. As per claim(s) 2,3 Gardell discloses method for establishing a connection between a calling party and a called party in a H.323 network, (See Column 4 Lines 13-64), receiving by a first gatekeeper a setup command (i.e., Admissions Request (ARQ)) issued from a connected calling user, (See Gardell Column 8 Lines 46-67) performing a user location algorithm by said first gatekeeper on its locally attached users, (See Gardell Column 8 Lines 55-60) if this algorithm fails, sending a Location Request message to its lower level gatekeepers, wherein each lower level gatekeeper (i.e., second gatekeepers) performs an user location algorithm on its attached users and lower level gatekeepers, (See Gardell Column 9 Lines 17-64) if these user location algorithms fail, sending a Location Request message to its higher level gatekeeper, which performs an user location algorithm on its attached users and gatekeepers except the originating gatekeeper, (See Gardell Column 9 Lines 17-65) if one of the user location algorithms succeeds, the gatekeeper concerned sending a Location Confirm message (i.e., LCF) to the first gatekeeper, (See Gardell Column 8 Lines 55-67) the first gatekeeper sending a Set-up message (i.e., ACF) to the gatekeeper which has issued the Location Confirm message, (See Gardell Column 8 Lines 55-67) which gatekeeper forwards said Set-up message to the called user, whereupon said connection is established (i.e., completing the call), (See Gardell Column 9 Lines 1-15).

#### **Conclusion**

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure

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- a. Patel et al. (US Patent No. 6,314,284) discloses system and method for providing service transparency for mobile terminating calls within an H.323 system;
  - b. Galasso et al. (US Patent No. 6,374,302) discloses method and system to provide an action control post master gatekeeper;
  - c. Li et al. (US Patent No. 6,591,301) discloses methods and systems for controlling network gatekeeper message processing; and
  - d. Bennefeld et al. (US Patent No. 6,519,249) discloses scalable gatekeepers in an Internet telephony system and a method of operation;
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sajid A Yussuf whose telephone number is (703) 305-8752. The examiner can normally be reached on Monday-Thursday 7:30-5:00 PM and Alternate Fridays.
10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (703) 305-4003. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.
11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sajid Yussuf  
Patent Examiner  
Technology center 2100  
29 June 2004

  
  
**RUPAL DHARIA**  
**SUPERVISORY PATENT EXAMINER**